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| 10/075,096 | 10/29/2001 | Carl E. Whitcomb | WHIT/0002 | 7255 |

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EXAMINER

NGUYEN, SON T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3643

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,096

Applicant(s)

WHITCOMB, CARL E.

Examiner

Son T. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 56** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "a polyethylene sheet" is unclear because it does not define which elements, the polymer sheet or the porous fabric, in claim 49 is a polyethylene sheet.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-11,13-16,18,19,25,26,29-35,41,42,44,46,48-53,55,56,63-65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger (US 6202348) in view of Berlitz et al. (GB 2,073,567 A).

For claims 1,15, Reiger discloses a root growth barrier comprising a layer of a root-tip-trapping material 120 snugly fitted to a layer of a root-impenetrable material 125. However, Reiger is silent about the material 120 bonded to the material 125. Berlitz et al. teach two layers 11,12 of material bonded to each other by laminating to form a plant container. It would have been obvious to one having ordinary skill in the art at the time

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the invention was made to bond the materials 120,125 of Reiger by laminating as taught by Berlitz et al. in order to further secure the two materials 120,125 together.

For claim 2, Reiger as modified by Berlitz et al. (emphasis on Reiger) further discloses the root-impenetrable material is water-impenetrable (as shown in fig. 9, cross-section of the assembly, the pot 24 is made of a plastic material which is a water-impenetrable material, especially in making flower pots.

For claim 3, Reiger as modified by Berlitz et al. (emphasis on Reiger) is silent about the material 120 being greater than 10 root-tip-trapping elements per square inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the root-tip-trapping material of Reiger as modified by Berlitz et al. being greater than 10 root-tip-trapping elements per square inch or 100 root-tip-trapping elements per square inch, since it has been held that where routine testing and general experimental conditions are present (the condition would be how many root tips one wishes to trap within the fabric), discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 4, Reiger as modified by Berlitz et al. (emphasis on Reiger) further discloses the root-tip-trapping material 120 being a porous fabric (col. 6, lines 22-67, col. 8, lines 67, col. 9, lines 1-15).

For claims 5,6, Reiger as modified by Berlitz et al. (emphasis on Reiger) discussed in col. 9, line 1, that the porous fabric has a weight of 8 ounce but not a weight between 2 and 10 ounces per square yard or between 4 and 6 ounces per square yard. It would have been obvious to one having ordinary skill in the art at the

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time the invention was made to have the porous fabric of Reiger as modified by Berlitz et al. weighing between 2 and 10 ounces per square yard or 4 and 6 ounces per square yard or between 4 and 6 ounces per square yard, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 7, Reiger as modified by Berlitz et al. (emphasis on Reiger) is silent about the fabric having openings between 1/16 and 1/4 inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the porous fabric of Reiger as modified by Berlitz et al. with openings between 1/16 and 1/4 inch, since it has been held that where routine testing and general experimental conditions are present (the condition would be finding the appropriate opening size of the porous fabric to grab the root tips), discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 8, Reiger as modified by Berlitz et al. (emphasis on Reiger) further discloses the porous fabric is spun bonded, needle punched fabric (col. 6, whole column).

For claim 9, Reiger as modified by Berlitz et al. (emphasis on Reiger) further discloses the porous fabric is made from polyester, polypropylene or polyolefin fibers (col. 6, lines 23-24).

For claim 10, Reiger as modified by Berlitz et al. (emphasis on Reiger) further discloses the porous fabric is a woven or knitted fabric (col. 6, whole column).

For claim 11, Reiger as modified by Berlitz et al.'s porous fabric is degradable since it is the same as used by applicant.

For claim 13, Reiger is silent about the porous fabric being opaque. In addition to the above, Berlitz et al. teach a plant container in which they employ an opaque inner layer 11 bonded to an outer layer 12, the opaque color is chosen because it prevents the transmission of light that may be harmful to roots (page 1, lines 101-105). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an opaque color as taught by Berlitz et al. for the porous fabric of Reiger in order to prevent the transmission of light that may be harmful to roots. Note, the examiner is relying on Berlitz et al. for a teaching of having an inner layer of a plant container being opaque and not a porous fabric.

For claim 14, Berlitz et al. further disclose that black is the preferred color for the inner layer 11 because of its prevention of the transmission of light that may be harmful for the roots (page 1, lines 101-105). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a black color as taught by Berlitz et al. for the porous fabric of Reiger in order to prevent the transmission of light that may be harmful to roots. Note, the examiner is relying on Berlitz et al. for a teaching of having an inner layer of a plant container being black and not a porous fabric.

For claim 16, Reiger is silent about the root-impenetrable material 24 being comprised of a plurality of layers. Berlitz et al. teach a plant container having a plurality of layers 11, 12, 13 in order to provide a strong plant container and to create a container

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with different color strata with different function such as light reflecting, decoration, etc.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a plurality of layers as taught by Berlitz et al. for the root-impenetrable material of Reiger in order to provide a stronger container and to create a container with different color strata with different function such as light reflecting, decoration, etc.

For claim 18, Reiger as modified by Berlitz et al. (emphasis on Reiger) root-impenetrable material 125 is made out of plastic material as shown in the cross-section. It is well known in the art of plastic making that the plastic starts out as polymer sheet and then molded into the desired shape or item. Therefore, the material 125 of Reiger as modified by Berlitz et al. is a polymer sheet rolled up into a circular formation.

For claim 19, Reiger is silent about the material 125 being polyethylene and polypropylene. In addition to the above, Berlitz et al. further teach the layers 5,6 of the plant container or the root-impenetrable material are made out of polypropylene because polypropylene displays high elasticity (page 2, lines 5-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ polypropylene as taught by Berlitz et al. as the preferred material for the root-impenetrable material of Reiger, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (high elasticity feature) as a matter of obvious choice. In re Leshin, 125 USPQ 416.

For claims 25,26, Reiger as modified by Berlitz et al. is silent about the root-impenetrable layer having a thickness between 2 and 10 mils or between 3 and 5 mils.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the thickness of the root-impenetrable layer of Reiger as modified by Berlitz et al. being between 2 and 10 mils or between 3 and 5 mils, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 29, see the above explanation. Note, ref. 125 is the container and ref. 120 is the material. Also, col. 7, line 67 and col. 8, line 1, state that the material 120 is snugly fitted to an inner wall of the container 125.

For claim 30, the container 125 is a typical "pot" shape which is cylindrical or circular.

For claims 31,32, Reiger as modified by Berlitz et al. is silent about the diameter of the container 125 being of various diameters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have various diameters for the container of Reiger as modified by Berlitz et al., since it has been held that where routine testing and general experimental conditions (to find the right diameter for the plant size) are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 33, see claim 8.

For claims 34,35, Reiger as modified by Berlitz et al. is silent about the fabric having various density. It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the density of the porous fabric of Reiger

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as modified by Berlitz et al., since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claim 41, see claim 14.

For claim 42, see claim 10.

For claim 44, Reiger teaches the container 125 being in-ground container (col. 7, line 40).

For claim 46, Reiger discloses a method of growing a plant in a pot comprising the steps of disposing a bilayer root growth barrier consisting essentially of a root-tip-trapping inner material 120 snugly fitted into a root-impenetrable material 125; disposing a growth medium adjacent to the root growth barrier (see figs. 8,9); and adding a plant 130 to the growth medium. However, Reiger is silent about the material 120 being bonded to the material 125. Berlitz et al. teach two layers 11,12 of material bonded to each other by laminating to form a plant container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to bond the materials 120,125 of Reiger by laminating as taught by Berlitz et al. in order to further secure the two materials 120,125 together.

For claim 48, see claim 1.

For claim 49, see claims 1,4,18.

For claim 50, see claim 6.

For claim 51, see claim 7.

For claim 52, see claims 1,8,10.

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For claim 53, see claim 9.

For claim 55, see claim 1.

For claim 56, see claims 19,25.

For claim 64, see claim 2.

For claim 63, as shown in fig. 9, cross section, the trapping layer 120 has a plurality of strata comprising of the fabric part (where ref. 120 points at) and the fuzzy part or surface (as shown in the figure). Therefore, the layer 120 of Reiger as modified by Berlitz et al. comprises a plurality of strata.

For claim 65, Reiger as modified by Berlitz et al. is silent about the trapping material 10 or 22 comprises greater than 100 root-tip-trapping elements per square inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the trapping material 10 or 22 of Reiger as modified by Berlitz et al. comprises greater than 100 root-tip-trapping elements per square inch, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

5. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Berlitz et al. as applied to claims 1,4,10,11 above, and further in view of Thomas (US 5311700). Reiger as modified by Berlitz et al. is silent about the porous fabric being cotton. Thomas teaches a root growth barrier such as a container for a plant in which he employed cotton for a root-growth resistant material 50 (col. 5, line 11). It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to employ cotton as taught by Thomas as the preferred material for the porous fabric of Reiger as modified by Berlitz et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (to trap and resist root growth) as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

6. **Claims 17,21,22,24,54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Berlitz et al. as applied to claims 1,4,10,11 above, and further in view of Van der Goobergh (EP 300578 A3).

For claim 17, Reiger as modified by Berlitz et al. is silent about the root-impenetrable material being reflective. Van der Goobergh teaches a seed trough having two layers 5,6 that are coated with a reflective material (page 2, col. 2, lines 7-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a reflective material as taught by Van der Goobergh on the root-impenetrable material of Reiger as modified by Berlitz et al. in order to reflect light and thus prevent harm to the roots.

For claims 21,22, in addition to the above, Van der Goobergh further discloses aluminum foil on the outer layer 6 of the plant container to reflect harmful light away from the plant (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ aluminum foil as taught by Van der Goobergh as the preferred material for the root-impenetrable material of Reiger as modified by Berlitz et al. in order to reflect harmful light away from the plant.

For claims 24,54, in addition to the above, Van der Goorbergh further discloses the root-impenetrable material 6 being a polymer sheet and the sheet is white (col. 2, line 55 and col. 3, line 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a white polymer sheet as taught by Van der Goorbergh as the preferred material for the root-impenetrable material of Reiger as modified by Berlitz et al. in order to reflect harmful light away from the plant (col. 2, lines 54-55).

7. **Claims 20,23,27,28,36-40,47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Berlitz et al. as applied to claim 1 above, and further in view of Flasch, Jr. (US 5,852,896).

For claim 20, Reiger as modified by Berlitz et al. is silent about the root-impenetrable material being metal. Flasch, Jr. teaches a plant container comprising a root-impenetrable material 28 that is made out of metal (col. 12, line 38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ metal as taught by Flasch, Jr. as the preferred material for the root-impenetrable material of Reiger as modified by Berlitz et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (strength and durability features of metal) as a matter of obvious choice. In re Leshin, 125 USPQ 416.

For claim 23, in addition to the above, Flasch further teaches using a UV inhibitor to provide UV light stability (col. 12, line 45) in the preferred material for his root-impenetrable layer 28 to block out harmful UV light or radiation. It would have been

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obvious to one having ordinary skill in the art at the time the invention was made to employ a UV inhibitors to provide high UV stability as taught by Flasch, Jr. in the root-penetrable layer of Reiger as modified by Berlitz et al. in order to block out harmful UV light or radiation.

For claims 27,28, Reiger as modified by Berlitz et al. is silent about the root-impenetrable material being biodegradable. In addition to the above, Flasch further discloses the root-impenetrable material 6 being biodegradable (col. 12, line 38, where Flasch discusses the material can be wood which is biodegradable). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ wood as taught by Flasch as the preferred material for the root-impenetrable material of Reiger as modified by Berlitz et al. because wood is biodegradable and environmentally friendly.

For claim 36, in addition to the above, Flasch further discloses the container being made out of polyethylene (col. 12, line 44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ polyethylene as taught by Flasch as the preferred material for the container 125 of Reiger as modified Berlitz et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (reduce cost) as a matter of obvious choice. In re Leshin, 125 USPQ 416.

For claims 37,38, Reiger as modified by Berlitz et al. and Flasch is silent about the polyethylene having a thickness between 2 and 10 mils or between 3 and 5 mils. It would have been obvious to one having ordinary skill in the art at the time the invention

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was made to have the thickness of the polyethylene of Reiger as modified by Berlit et al. and Flasch being between 2 and 10 mils or between 3 and 5 mils, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

For claims 39,40, in addition to the above, Flasch further teaches using a UV inhibitor to provide UV light stability (col. 12, line 45) in the preferred material for his root-impenetrable layer 28 to block out harmful UV light or radiation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a UV inhibitors to provide high UV stability as taught by Flasch, Jr. in the polyethylene of Reiger as modified by Berlit et al. and Flasch in order to block out harmful UV light or radiation.

For claim 47, Reiger as modified by Berlit is silent about the outer material 125 being biodegradable. Flasch further discloses the root-impenetrable material 6 being biodegradable (col. 12, line 38, where Flasch discusses the material can be wood which is biodegradable). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ wood as taught by Flasch as the preferred material for the root-impenetrable material of the method of Reiger as modified by Berlit et al. because wood is biodegradable and environmentally friendly. Note, see claim 46 for similar method explanation.

8. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Berlit et al. as applied to claim 29 above, and further in view of

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Kalpin (US 3,094,810). Reiger as modified by Berlitz et al. is silent about the container being assembled by sewing. Kalpin teaches a container for plant made out of semi-rigid sheets of material such as paper or cloth that are sewed together to form the container (col. 1, lines 62-71). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a container made up of semi-rigid sheets that are sewed together as taught by Kalpin in place of the container of Reiger as modified by Berlitz et al. in order to provide a container that is easy to store and reduce shipping costs (col. 1, lines 13-15 of Kalpin).

9. **Claim 45** is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Berlitz et al. as applied to claims 29,33 above, and further in view of Billings (US 6,223,466 B1). Reiger is silent about the container 125 being a production pot in pot-in-pot production. Billings teaches a planting system that is a production pot-in-pot in which a primary pot 20 is installed in a soil and a second pot 12 is inserted into the primary pot for purpose of growing a tree or shrub (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the container of Reiger as modified by Berlitz et al. be a production pot in pot-in-pot production as taught by Billings in order to allow a user with the versatility of placing and removing the inner pot from the outer pot whenever desired and to interchanged from one location to another location by replacing one inner container from an outer container with another similar inner container (see abstract of Billings).

10. **Claims 57,59-62** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger (US 6202348) in view of Berlitz et al. (GB 2,073,567 A) and Flasch, Jr. (US 5,852,896).

For claim 57, see claims 1,4,8,10,36.

For claim 59, see claim 1.

For claim 60, see claim 19.

For claims 61,62, see claims 5,6.

11. **Claim 58** is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiger as modified by Berlitz et al. and Flasch, Jr. as applied to claim 57 above, and further in view of Van der Goobergh (EP 300578 A3). See claims 14,24.

Response to Arguments

12. Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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A handwritten signature in black ink, appearing to read "Son T. Nguyen", with a long, sweeping horizontal stroke extending to the right.

Son T. Nguyen

Patent Examiner, GAU 3643

March 24, 2003